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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/627,731
Filing Date: July 28, 2000
Appellant(s): MAENG, JOON

Kelly K. Kordzik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/03/06 appealing from the Office action
mailed 07/15/03.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,343,314	Ludwig et al.	01/2002
6,342,906	Kumar et al.	01/2002

(9) Grounds of Rejection

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The following ground(s) of rejection are applicable to the appealed claims:

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4, 10, 11-16, 19-21, 25, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Ludwig et al. [US. 6,343,314].

As per independent claim 1, Ludwig teaches a method of displaying an electronic file to a primary user having a primary workstation, said primary workstation coupled to a global computer network, and at least one secondary viewer at a remote location, comprising:

accessing a first file and displaying said first file on said primary workstation (fig. 37, col. 36, lines 64-65);

displaying said first file at said remote location on a secondary workstation, said secondary workstation coupled to said global computer network (fig. 37, col. 36, lines 64-65);

accessing a second file, said second file comprising information relating to said first file; and displaying said second file only on said primary workstation as an overlay to said first file, wherein said second file is not viewable by said at least one secondary viewer. According to col. 36, lines 62-64, the Expert (primary user) can create a second file displayed on his workstation and this second file is not viewable by the secondary viewers until he decides to share it.

As per claim 2, which is dependent on claim 1, it is inherent in Ludwig's system that the second file comprises annotations to the first file because the Expert would create the second file in order to support the sharing first file.

As per claim 4, which is dependent on claim 1, Ludwig teaches the first file and the second file being stored in a server computer (col. 28, lines 31-42).

As per claim 10, which is dependent on claim 1, Ludwig teaches activating said first file for editing by said at least one secondary viewer (col. 36, lines 65-67 through col. 37, lines 1-6).

As per independent claim 11, Ludwig teaches a method of synchronous collaboration between a plurality of remote users, each of said plurality of remote users having a user workstation, each of said user workstations being interconnected via a network of interconnected computers, wherein a first one of said plurality of remote users is a host, comprising:

accessing a file for said collaboration, said file having first and second states, in which data stored in said first state is displayed to all of said plurality of remote users, and in which data stored in said second state is displayed only to said host as an overlay to said first state; displaying said file on said plurality of user workstations, wherein said data stored in said second state is only displayed to said host, and wherein said data stored in said first state is displayed to said host and to said plurality

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of remote users. Col. 36, lines 62-65 clearly shows that when the file, generated by the Expert, is not in the shared state (second state), only the Expert can view the file; however, when the file is in the shared state (first state), the Expert and remote clients can view the file.

enabling at least one of said plurality of remote users to edit said data stored in said first state (col. 36, lines 65-67 through col. 37, lines 1-6).

As per claim 12, which is dependent on claim 11, Ludwig teaches the network comprising a videoconference system (col. 10, lines 13-35).

As per claim 13, which is dependent on claim 11, according to Ludwig's system as described in claim 11 above because the file is generated by the Expert, it must be stored in a location remote to any of said plurality of remote users.

As per claim 14, which is dependent on claim 13, Ludwig teaches the file comprising a first file and a second file, wherein said first file comprises said data stored in said first state (share), and said second file comprises said data stored in said second state (not share) (col. 36, lines 62-65).

As per claim 15, which is dependent on claim 14, it is inherent in Ludwig's system that the first file and said second file are stored in separate memory units.

As per claim 16, which is dependent on claim 15, Ludwig teaches a plurality of third files, each of said plurality of third files comprising a personal file of one of said plurality of remote users (col. 36, lines 59-60).

As per independent claim 19, Ludwig teaches a system for videoconferencing, comprising:

a first workstation having at least a first and second memory unit, said first memory unit adapted to store a first file (fig. 37, col. 36, lines 64-65), said second memory unit adapted to store a second file, said second file comprising information relating to said first file (fig. 37, col. 36, lines 64-65);

at least one video display located remote to said first workstation, said at least one video display interconnected to said first workstation (fig. 18A); and

said first workstation containing programmed instructions to cause the first file to be displayed on both the first workstation and the at least one video display, and to cause the second file to be displayed only on the first workstation as an overlay to said first file. According to col. 36, lines 62-64, the Expert (primary user) can create a second file displayed on his workstation and this second file is not viewable by the secondary viewers until he decides to share it.

As per claim 20, which is dependent on claim 19, because Ludwig's system is a video conferencing system, it is inherent for the system to have VGA memories.

As per claim 21, which is dependent on claim 20, it is similar scope to claim 2; therefore, it should be rejected under similar rationale.

As per independent claim 25, it is a similar scope to claim 1; therefore, it should be rejected under similar rationale.

As per claim 26, which is dependent on claim 25, Ludwig teaches the machine-readable storage medium includes any of magnetic storage medium, including disk and tape storage medium; optical storage medium, including compact disk memory and digital video disk storage medium; nonvolatile memory storage memory; volatile storage medium; and modulated, electronic signals (col. 30, lines 30-67 through col. 31, lines 1-67 and through col. 32, lines 1-44).

Claims 3, 5-9, 17, 18, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig in view of Kumar et al. [US 6,342,906].

As per claim 3, which is dependent on claim 2, Ludwig does not disclose the displaying further comprises displaying said first file on plural secondary workstations and wherein the second file is displayed as an overlay to said first file on selected but not all of said plural secondary workstations. Kumar discloses in col. 2, lines 37-57 that an authorized user in a network can mark the annotation layer to the shared file while at the same time can block the other participants from editing the share file. It would have been obvious to an artisan at the time of the invention to use the teaching from Kumar

of displaying the second file as an overlay to the first file in Ludwig's method since it would allow the user to put notes or comment on the first file.

As per claim 5, which is dependent on claim 4, Ludwig does not disclose said first file and said second file are a single file, and further wherein said second file contains a code to indicate that said second file is not for display at said secondary workstation. According to Kumar in col. 2, lines 29-37, annotation layer is a file combined of different files and at the option of the participants, the annotation layer can be visible or invisible (depends on the code to indicate that it can be visible or invisible). It would have been obvious to an artisan at the time of the invention to use the teaching from Kumar of said first file and said second file are a single file, and further wherein said second file contains a code to indicate that said second file is not for display at said secondary workstation in Ludwig's method since it would serve as security purposes.

As per claim 6, which is dependent on claim 3, it is inherent in Ludwig system that the Expert's workstation (primary workstation) comprises a plurality of memory units, and wherein said first file is stored in a first memory unit and said second file is stored in a second memory unit.

As per claim 7, which is dependent on claim 6, this claim is rejected under the same rationale as claim 3.

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As per claim 8, which is dependent on claim 7, Ludwig teaches the global computer network comprises a video conferencing system (col. 10, lines 13-35).

As per claim 9, which is dependent on claim 3, Ludwig teaches the primary user comprises a customer service representative (*the Expert*, col. 36, lines 48-50) and said secondary viewer comprises a customer (*client*, col. 36, lines 48-50), and the internet is a global network connecting millions of computer.

As per claim 17, which is dependent on claim 16, it is rejected under the same rationale as claim 3.

As per claim 18, which is dependent on claim 17, Ludwig teaches a common annotation file, said common annotation file relating to said first file and accessible by more than one of said plurality of remote users (col. 36, lines 65-67 through col. 37, lines 1-6).

As per claims 22, 23 and 24, which are dependent on claims 21, 20 and 19 respectively, they are rejected under the same rationale as claim 3.

(10) Response to Argument

Appellant's argument to claims 1, 11, 19 and 25.

(a) Appellant has argued that Ludwig fails to teach, suggest or disclose an **“overlay”** as recited by claims 1, 11, 19 and 25.

The Examiner does not agree. Claim 1 claims “displaying said second file only on said primary workstation as an **overlay** to said first file, wherein said second file is not viewable by said at least one secondary viewer”. Ludwig clearly teaches a method or system having an “overlay” displayed over a first file at a primary workstation and “not viewable” on a secondary workstation. According to Ludwig in col. 36, lines 61-67 through col. 37, lines 1-13, “the Expert illustrates his advice by creating (using his own modeling software) and sharing a new graphical image 220 (FIG. 37) with the field representative and his client.” At the time that the Expert creates his own image (221 of fig. 37), **which comments about the first discussed image** (220 of fig. 37), only he himself can view this image. The field representative and his client (secondary workstation) cannot view this image until the Expert decides to share it (col. 36, lines 53-58). **The new created image (221 of fig. 37) is in fact an “overlay” displayed over the first image file (210 of fig. 36)** to include annotations to the first image file.

(b) Appellant has argued that the Examiner maintains the rejection by construing the term **“overlay”** as disclosed by a file that makes unviewable a file beneath the overlay. Appellant submits that the term “overlay” is clearly defined in Applicant’s written description (page 2, lines 31-33 and page 7, lines 20-27) to preclude the Examiner’s suggested construction.

The Examiner does not agree. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the

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features upon which applicant relies (i.e., the written description in page 2, lines 31-33 and page 7, lines 20-27) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, "**overlay**" can still be read in light of Ludwig's teaching because ***the newly created second image (221 of fig. 37) is, in fact, an "overlay" displayed over the first image file (210 of fig. 36).***

As indicated in the original specification (page 2, lines 31-33), the definition of "overlay" is described as "the annotation file **may be** displayed as an overlay to the target file, so that the leader **can view** both the target file, as seen by all users, and the annotation file, which is only seen by the leader.". The examiner notes that "May be" and "Can view" do not qualify the definition because the annotation file **is displayed or is not displayed** as an overlay to the target file. Similarly, the leader can view or can not view both the target file of the overlay and its underneath one.

(c) The Examiner's suggested construction of the term overlay directly contradicts Applicant's written description and would defeat the very purpose of Applicant's invention by preventing a user from viewing the user's annotations over the user's presentation. Ludwig fails to teach suggest or disclose any display in which the image 220 is **visible through** the image 221 and therefore fails to teach, disclose or suggest the recited "overlay".

The Examiner does not agree. According to Applicant's above argument, "Ludwig fails to teach, suggest or disclose any display in which the image 220 is **visible through**

the image 221". By that, and by the "overlay" definition in page 2, lines 31-33 and page 7, lines 20-27 of the specification, ***the invention is about "transparent" or "see through" overlay, while the claimed language is only about "overlay"; however, the applicant did not claim this invention feature as argued.*** These two terms, in fact, have different implication. "***Overlay***" alone can still be read in light of Ludwig's teaching because ***the newly created second image (221 of fig. 37) is, in fact, an "overlay" displayed over the first image file (210 of fig. 36).***

Appellant's argument to claims 3, 5-6, 8-9 and 18:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ludwig shows a multimedia collaboration system that greatly facilitates distributed collaboration, in part by replicating the benefits of face-to face collaboration. The system tightly integrates a carefully selected set of multimedia and collaborative capabilities, principal among which are desktop teleconferencing and multimedia mail while Kumar's system shows effective real-time collaboration across remote sites in which any type of data can be shared in a common work space in a consistent manner is made possible by an annotation layer having multiple distinct modes of operation during a collaborative

session with two or more people sharing the same work space. Both references are directed to a system for electronic-based communication between a plurality of remote users who can simultaneously view and share data in a common work space. Both references have a same work environment and there is a motivation to combine.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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